Remarks

Claims 1-13 and 15-26 are pending in the present application, claim 14 having been canceled by this amendment.

Applicants traverse the objection of claims 1-13 as indefinite. Claim 1 has been amended to address the issues raised by the examiner in this regard. In particular, the step of determining with respect to the second book has been added.

Applicants traverse the rejection of claims 1-26 as obvious over de Heus et al. in view of Nussbaum et al. and Fannin et al.

Claim 1, and claims 2-26 directly or indirectly dependent thereon, specify a method of assembling first and second different books, wherein the method includes the step of storing a first number of pages. The method further includes the steps of specifying a first set of pagination information including an indication of whether a stored page is to be selectively included in the first book and specifying a second set of pagination information including an indication of whether a stored page is to be selectively included in the second book. Still further, the method includes the steps of determining whether a stored page is to be assembled into the first book based on the first set of pagination information wherein a second number of stored pages to be assembled into the first book is less than the first number and determining whether a stored page is to be assembled into the second book based on the second set of pagination information wherein a third number of stored pages to be assembled into the second book is different than the second number and no greater than the first number. In addition, the method includes the steps of generating page description language instructions for production of the first and second books in accordance with the first and second sets of pagination information and producing first and second books in a single press run.

None of de Heus et al., Nussbaum et al., and Fannin et al. discloses or suggests a method of assembling first and second different books including the steps of determining whether a stored page is to be assembled into the first book based on a first set of pagination information where a second number of stored pages to be assembled into the first book is less than a first number and determining whether a stored page is to be assembled into the second book based on the second set of pagination information where a third number of stored pages

to be assembled into the second book is different than the second number and no greater than the first number. In addition, none of de Heus et al., Nussbaum et al., and Fannin et al. discloses or suggests the step of producing such first and second books in a single press run.

In fact, de Heus et al. discloses a pagination system and process for paginating types of printed book directories such as telephone books, membership directories, catalogues, etc. For each type of directory, the pagination system accepts a plurality of data entries and a set of layout and pagination parameters. The data entries and layout and pagination parameters are specified for each directory type. The system uses the layout parameters to define the general appearance or physical characteristics of a book page or sections of the book and the pagination parameters are used during pagination to control the position of the display entries and anchor listings and headings relative to the column and page boundaries. During pagination, an optimal page layout is created for each page of the book directory in order to minimize waste of available printing space. Page description language is generated for each page of the book directory for production thereof on a suitable output device, such as a laser printer or typesetter. Significantly, all of the book directories of a particular directory type are identical to one another as printed.

Nussbaum et al. teaches a custom book assembly and binding system wherein a combination of pages is selectively included in a book assembly. According to Nussbaum et al., in order to create multiple distinct copies of a book, more than a single press run is required. Nussbaum et al. proposes increasing processing speeds by using shorter bindery lines. To facilitate the use of fewer hoppers, the hoppers used must be continually recycled or reused for more than one set of signatures. (See Column 4, Lines 18-25.)

Fannin et al. discloses an apparatus and method for printing different indicia, such as account numbers, on documents without changing plates or stopping a press during a press run. The plate transfers images to a blanket, wherein the blanket includes a portion that does not contact the plate, and thus receives no image therefrom. The images are thereafter transferred to sheets passing through the press. A differential drive selectively displaces an angular position of the plate on the fly relative to the blanket, so that a different set of indicia becomes aligned with the portion of the blanket that does not already contain images. As seen in FIG. 4, Fannin et al. discloses printing different indicia on a precollated paper stack, wherein the papers printed for each indicia do not differ.

Applicants contend that it is not appropriate to combine de Heus et al. and Nussbaum et al. to reject the claims herein. A person of ordinary skill in the art would not have looked to the teachings of Nussbaum et al. to modify de Heus et al. because de Heus et al. relates to a pagination system and Nussbaum et al. relates to a binding line. The pagination system of de Heus et al. is a front-end system that produces page description language (PDL) instructions to be sent to an output device, in particular, a laser printer or typesetter. The binding line of Nussbaum is only responsive to commands that specify which signatures to include in a book. These commands are not in an output-oriented language that is used to create a printed or other representation of a page. Accordingly, the binding line of Nussbaum et al. is not responsive to and cannot accept PDL instructions. Therefore, any attempt to combine features of de Heus et al. and Nussbaum et al. would result in a system that would be inoperative, and hence, it would have not been obvious to combine de Heus et al. with Nussbaum et al. in order to arrive at the subject matter recited by the claims of the present application.

Because the prior art does not disclose or suggest that it would be desirable or even possible to provide a method of assembling first and second different books including the recited determining steps or the producing step, as specified by the claims at issue, such claims are not obvious thereover. The prior art must disclose at least a suggestion of an incentive for the claimed combination of elements in order for a *prima facie* case of obviousness to be established. See *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Accordingly, the obviousness rejection should be withdrawn.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims at issue and allowance thereof are respectfully requested.

Respectfully submitted,

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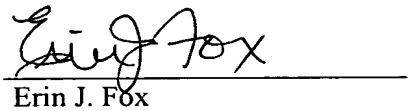
By: 
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